

REMARKS

At the outset, Applicants wish to thank the Examiner for reviewing and considering the pending application. The Office Action dated October 18, 2006, has been received and reviewed.

Claims 1-4 have been amended. No new matter has been added. Currently claims 1-15 are pending. Applicants respectfully request reconsideration of the pending claims.

The Office Action rejects claims 1-3 and 5 under 35 U.S.C. 102(b) as anticipated by or in the alternative under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 5,536, 612 to Yamaguchi et al. (hereinafter “Yamaguchi”). The Office Action also rejects claims 4 and 6-15 under 35 U.S.C. 103(a) as unpatentable over Yamaguchi. Applicants respectfully traverse these rejections.

To be anticipatory, a prior art reference must teach every element of the claim. Furthermore, to render a claim obvious, the prior art must teach or suggest each and every element of the claim. Yamaguchi fails to teach or suggest every element of any of claims 1-4. Accordingly, Yamaguchi cannot anticipate claims 1-3 and 5, and cannot render obvious claims 1-15.

Claims 1-4, recite, *inter alia*, “the toner is comprised of toner particles with pigments and charge control agents on the surface of said toner particles.” Yamaguchi fails to teach this feature of the claim. In fact, Yamaguchi teaches the exact opposite, “in the present invention , a coloring agent is contained in the core material of the encapsulated toner.” *See Yamaguchi*, col. 11, ll. 3-7. This distinction is material and non-obvious. This feature of the claimed invention gives unexpected results as discussed on pages 10-13 and 24-39 of the specification. As such, claims 1-4 are patentable over Yamaguchi. Claims 5-15 variously depend on claims 1-4 and

thus are patentable over Yamaguchi at least for the same reasons as claims 1-4. Applicants, therefore, respectfully request withdrawal of these rejections.

The application is in a condition for allowance and favorable action is respectfully solicited. If for any reason the Examiner believes a conversation with the Applicant's representative would facilitate the prosecution of this application, the Examiner is encouraged to contact the undersigned attorney at (202) 496-7500. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911. A duplicate copy of this sheet is enclosed.

Dated: January 18, 2007

Respectfully submitted,

By 
Mark R. Kresloff
Registration No.: 42,766
McKENNA LONG & ALDRIDGE LLP
1900 K Street, N.W.
Washington, DC 20006
(202) 496-7500
Attorneys for Applicant